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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/235,242	01/22/1999	WOLFGANG FRIEDRICH	48746	4979

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EXAMINER
STOCKTON, LAURA

ART UNIT	PAPER NUMBER
1626	31

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on February 20, 2003

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), [redacted] whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-6 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 2-6 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/235,242

★ U.S. GPO: 1996-404-496/40517

DETAILED ACTION

Claims 2-6 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green {U.S. Pat. 4,617,154}, Sullivan, III et al. {U.S. Pat. 4,231,956} and O'Lenick, Jr. et al. {U.S. Pat. 5,196,589}, in combination with each other.

Applicants claim a process of making a γ-alkoxyamine by reacting an α, β-unsaturated nitrile with an alcohol in the presence of a basic catalyst (e.g., a diazabicycloalkene catalyst) to form a β-alkoxynitrile followed by hydrogenation of the β-alkoxynitrile in the presence of a hydrogenation catalyst (e.g., Raney nickel) to obtain a γ-alkoxyamine.

Green teaches a process of making a β-alkoxynitrile and a β-alkylthionitrile by reacting an α, β-unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst (see columns 1 and 2). However, Green does not teach the total scope of Applicants' diazabicycloalkene catalysts or Applicants' claimed hydrogenation step.

Sullivan, III et al. teach additional diazabicycloalkene catalysts useful in the preparation of a β-alkylthionitrile (column 5, lines 13-25).

O'Lenick, Jr. et al. teach a process of making a β-alkoxynitrile by reacting an α, β-unsaturated nitrile with an alcohol in the presence of a basic catalyst (see column 2, lines 1-9 and column 4, lines 35-42). O'Lenick, Jr. et al. further teach that a β-alkoxynitrile (the products also taught by Green) can undergo a hydrogenation process, without separation or neutralization of the basic catalyst, in the presence of a suitable catalyst (e.g., Raney nickel) to form a γ-alkoxyamine (column 2, lines 1-9 and column 4, lines 48-53).

The claimed process is no more than a selective combination of prior art teachings done in a manner obvious to one of ordinary skill in

the art since each step of the process appears to be relatively complete in itself and there is no indication of an interaction between steps of such a type that would lead one of ordinary skill in the art to doubt that a substitution of alternative steps known to the art could be made. *In re Mostovych*, 144 USPQ 38 (1964).

One skilled in the art would have been motivated to utilize the process of Green, especially in view of the teachings of Sullivan, III et al. and O'Lenick, Jr. et al., to arrive at the instant claimed process with the expectation of obtaining a γ-alkoxyamine. The claimed process would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Response to Arguments

Applicants' arguments filed February 20, 2003 have been fully considered. Applicants argue that: (1) O'Lenick, Jr. et al. teach away from Applicants' claimed invention; (2) O'Lenick, Jr. et al. teach that the

reaction has to be performed in the presence of an added stable free radical compound; (3) the critical difference between the prior art and the claimed invention is the catalyst, namely the diazabicycloalkene catalyst; (4) comparative experimental data reveal the unexpected results of Applicants' claimed invention where O'Lenick, Jr. et al. fail; and (5) Applicants' invention provides a solution to a long-felt need and that is finding an improved process for preparing γ-alkoxyamine which is obtained in higher yield than the prior art.

All of Applicants' arguments have been considered but have not been found persuasive. Applicants claim a process of making a γ-alkoxyamine. The combination of Green, Sullivan, III et al. and O'Lenick, Jr. et al. teaches Applicants' claimed process of making a γ-alkoxyamine. In response to Applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The

test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bent*, 52 CCPA 850.

In the decision by the BPAI on August 21, 2002, the BPAI stated, "Even if we were to accept the appellants' argument regarding the preclusion of the beneficial free radical inhibitor in the claims on appeal, our conclusion would not be altered. As indicated *supra* , O'Lenick specifically teaches that its process can be carried out without any free radical inhibitors" (see page 8 of the decision).

Applicants' comparison of percentage yields is not persuasive since a true side-by-side comparison of unexpected, superior and beneficial results of the instant invention over the prior art has not been performed. Further, Attorney's arguments of unexpected results cannot take the place of evidence in the record. *In re DeBlauwe*, 736 F.2d 699, 705.

For all the reasons given above, the instant claimed invention is found to have been obvious to one skilled in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

May 12, 2003